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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,684	10/08/2004	Noriko Endou	Q83593	3894
23373 7590 02/13/2007 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER PENG, KUO LIANG	
			ART UNIT 1712	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/13/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/510,684

Applicant(s)

ENDOU ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/22/06 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5, 7-14 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-14 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. The Applicants' amendment filed November 22, 2006 is acknowledged. Claims 2, 6 and 15-18 are deleted. Claims 1 and 3-4 are amended. Now, Claims 1, 3-5, 7-14 and 19-21 are pending.

2. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 081906) is/are removed.

2. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 7 (line 1), “claim 6” causes confusion because a claim cannot depend on a canceled claim.

In Claim 10 (line 2), “claim 2” causes confusion because a claim cannot depend on a canceled claim.

Double Patenting

5. Rejection of Claims 1, 5 and 7-9 under double patenting rejection is maintained because the rejection is adequately set forth in paragraph 7 of Paper No. 081906.

Applicants intend to defer the response to the instant rejection.

Claim Rejections - 35 USC § 102 and 103

6. Rejection of Claims 12 and 14 under 35 USC 102(b) as being anticipated by Nakagawa (US 6 274 688) and rejection of Claims 13 and 19-20 under 35 USC 103(a) as being unpatentable over Nakagawa are maintained because the rejection is adequately set forth in paragraphs 9 and 13 of Paper No. 081906. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 11, last paragraph, page 12, 2nd paragraph and page 15, 2nd paragraph), as mentioned in the previous Office action, Nakagawa is silent on preparing the (co)polymers via anionic polymerization set forth in the present invention. However, the instant claims are product-by-process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process" In re Thorpe, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). In addition, Applicants are reminded that Nakagawa does teach the use of conjugated dienes. (col. 4, line 60 to col. 5, line 50)

For Applicants' argument (Remarks, page 12, 1st paragraph), the function of the claimed condensation accelerator is to facilitate the condensation of the hydrocarbyloxysilane compound residue introduced into the active site of the polymer or condensation with the hydrocarbyloxysilane compound (Specification, page 22, 2nd paragraph). In other words, the condensation accelerator is the same as Nakagawa's curing catalyst where the curing catalyst functions the same manner as the claimed condensation accelerator does.

7. Rejection of Claims 1-12 and 14 under 35 USC 102(b) as being anticipated by JP906 (JP 56-104906) and rejection of Claims 13 and 19-21 under 35 USC 103(a) as being unpatentable over JP906 are maintained because the rejections are adequately set forth in paragraphs 10 and 14 of Paper No. 081906. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 12, last paragraph and page 15, 2nd paragraph), Examiner disagrees because JP906 does teach the use of a condensation accelerator. (paragraph 7)

For Applicants' argument (Remarks, page 13, 1st paragraph), n in formula (1) can be 0 and Y can be methoxy group, etc. (paragraphs 11-12)

For Applicants' argument (Remarks, page 13, 2nd paragraph), it appears that the molecular weight is not claimed.

8. Rejection of Claims 12 and 14 under 35 USC 102(b) as being anticipated by JP998 (JP 2000-086998) and rejection of Claims 13 and 19-20 under 35 USC 103(a) as being unpatentable over JP988 are maintained because the rejections are adequately set forth in paragraphs 11 and 17 of Paper No. 081906. Applicant's

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arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 13, last paragraph to page 14, 2nd paragraph and page 15, 4th paragraph), as mentioned in the previous Office action, JP998 is silent on preparing the (co)polymers via anionic polymerization set forth in the present invention. However, the instant claims are product-by-process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process" In re Thorpe, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). JP998's silyl group does contain alkoxy groups. ([0005])

For Applicants' argument (Remarks, page 14, 3rd paragraph), JP998 teaches the use of butadiene, isoprene, etc. ([0005])

9. Rejection of Claims 1, 3-5, 7-14 and 19-21 under 35 USC 103(a) as being unpatentable over Haynes (EP 067 468/US 4 379 891) in view of Ishikawa (US 6 191 247), rejection of Claims 1, 3-5, 7-14 and 19-21 under 35 USC 103(a) as being

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unpatentable over Ozawa (WO 01/34658/US 6 992 147) **optionally** in view of Ishikawa, rejection of Claims 1, 3-5, 7-14 and 19-21 under 35 USC 103(a) as being unpatentable over Takeishi908 (US 6 228 908) in view of Ishikawa, rejection of Claims 1, 3-5, 7-14 and 19-21 under 35 USC 103(a) as being unpatentable over Hogan (US 6 573 412) in view of Ishikawa, rejection of Claims 1, 3-5, 7-14 and 19-21 under 35 USC 103(a) as being unpatentable over Morita (US 6 369 167) in view of Ishikawa, rejection of Claims 1, 3-5, 7-14 and 19-21 under 35 USC 103(a) as being unpatentable over Takeichi295 (US 6 008 295) in view of Ishikawa are maintained because the rejections are adequately set forth in paragraphs 15-16 and 18-21 of Paper No. 081906. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 16, last paragraph), Applicants are advised that Ishikawa' silanol condensation catalyst is blended in a dry mixing stage for the rubber composition. As such, it is indeed added to the reaction system **after completion** thereof. Also, the instant claims are rejected over Ozawa, **optionally** in view of Ishikawa.

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10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval

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(PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp

February 12, 2007



Kuo-Liang Peng
Primary Examiner
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